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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,937	08/08/2000	Patrick Egan	20181-2	4122

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EXAMINER

NGUYEN, CHI Q

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 02/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/633,937

Applicant(s)

EGAN, PATRICK

Examiner

Chi Q Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-8, 11, 14-16, 19, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter (U.S. Pat. No. 5,771,645), (U.S. Pat. No. 5,497,589) in view of Menchetti (U.S. Pat. No. 5,383,317).

Porter (-645) discloses an electrical access in structural insulated foam core panels comprising a first and second exterior facing sheets made from plywood, drywall, or composite gypsum 12, 14, a first and second interior facing into foam core (unlabeled), an insulated foam core 16, an electrical box 42, electrical conductors 78, 80, wire chase 20, apertures 60, 64 (see Figs. 1, 5-6) Porter (-589) discloses a structural insulated panels including a first vertical side edge having a male projection member with edge strips 129a, 129b, adapted to project into a corresponding female reception member on a adjacent panel with edge strips 134a, 134b (see Fig. 7).

Porter's (-645, -589) disclosure does not show framing struts being located between first and second sheet. Menchetti (-317) teaches a shaft wall cavity extension including a pair of flanges 22 locating in between the first and second panels (see Fig. 1). At the time of the invention, it would have been obvious to a person of ordinary skill in the art

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to combine Porter (-645), (-589) and Menchetti (-317). The motivation for doing so would have been to provide an electrical conduction within the insulated panel system.

3. Claims 1, 4, 5, 9, 10, 12-13, 17-18, 20, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter (U.S. Pat. No. 5,771,645), (U.S. Pat. No. 5,497,589) in view of Menchetti (U.S. Pat. No. 5,383,317).

Porter (-645), (-589) and Menchetti (-317) disclose the claimed invention except for the tolerance of the thickness of the struts and panel. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to obtain critical tolerance of the thickness, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

4. Applicant's arguments filed on 11/29/01 that the four +/- 1/4 inches panel thickness is an industrial declaration by Dave Sheidler and Ray Micham who have discovered the right thickness value in order to fit around windows or doors without jamb have been fully considered but they are not persuasive. Examiner considers all the conventional foaming panels have specific thickness and R-value for better insulation in order to have energy cost saving. Thickening the panels, higher R-value, these are engineering design choices.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication should be directly to Chi Q. Nguyen whose telephone number is (703) 605-1224, Monday-Thursday (7:00-5:00), Fridays off or the examiner's supervisor Carl D. Friedman at (703) 308-0839.

CQN 2/11/02



Carl D. Friedman
Supervisory Patent Examiner
Group 3600